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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,948	01/29/2002	David G. Hugley	5150-64300	7153

7590 03/16/2007
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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT	PAPER NUMBER
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2167

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/059,948

Applicant(s)

HUGLEY, DAVID G.

Examiner

Cheryl Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/10/03 & 7/17/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-104 are presented for examination.

INFORMATION DISCLOSURE STATEMENT

2. The information disclosure statement (IDS) submitted on December 10, 2003 and July 17, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-104 are rejected under 35 U.S.C. 102(e) as being anticipated by Coult (Publication No.: US 2002/0035571, filed September 4, 2001, priority to provisional application no. 60/233,324 filed September 15, 2000 and priority to provisional application no. 60/289,422 filed May 8, 2001).
5. Regarding Claims 1, 24, 36, 58, 82, 85, 86, 89, 92, 93, 94, and 100, Coult teaches a digital patent marking method.

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The method and associated system for a digital patent marking method as taught or suggested by Coult includes:

detecting one or more resources (figure 1, element 28, patent categorization engine, ¶¶0058, 'categorizing or mapping of patents to products') coupled to or comprised in a computer system (¶¶0045-0046, 'World Wide Web or any other Internet Facility'; and figure 1, ¶¶0058 and 0130); retrieving patent marking information (¶¶0042-0045, figure 1, element 20, patent marking service, ¶¶0067-0073, 0077, and 0130-0131) corresponding to each of one or more resources; displaying patent marking information (¶¶0050, 'Bar code labels can display relevant patent data'); a memory (¶¶0035 and 0119) operable to store program instructions (¶¶0119, 'include a means for entering or programming data', ¶¶0126, 'machine readable code'); a processor (¶¶0115, 0119, and 0161); a display (¶¶0050, 0117, and 0138) coupled to the processor; downloading one or more software products (¶¶0053, 'the product is downloaded software' and ¶¶0092) to a computer system from a server over a network (¶¶0046); patent marking database (¶¶0039 and 0061) in response to identifying (¶¶0039 and 0061).

6. Regarding Claim 2, Coult teaches one or more hardware devices (¶¶0149 and 0156) coupled to the computer system.

7. Regarding Claims 3 and 59, Coult teaches the one or more resources comprise one or more software programs installed on the computer system (¶¶0156).

8. Regarding Claim 4, 5, 7, 10, 11, 19, 20, 25-27, 29, 30, 34, 35, 37-40, 42, 45, 46, 53, and 54, the limitations of these claims have been noted in the rejections of

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independent claims 1, 24, 36, 58, 82, 85, 86, 89, 92, 93, 94, and 100 presented above.

They are therefore rejected as set forth above.

9. Regarding Claims 6, 28, and 41, Coult teaches one or more resources stored identification information which identifies the respective resource (§§ 0059 and 0101); detecting comprises retrieving ID information (§§0039, 0051, 0077, 0128, and 0140); and retrieving patent marking information is performed based on ID information (§§0039, 0051, 0077, 0128, and 0140).

10. Regarding Claims 8 and 43, Coult teaches patent marking database periodically (§§0052, 0069, 0071, and 0073).

11. Regarding Claims 9 and 44, Coult teaches updating patent marking database when resources are detected whose patent marking information is not stored in the patent marking database (§§0052, 0069, 0071, and 0073).

12. Regarding Claims 12 and 47, Coult teaches displaying patent marking information on a computer display for a specified period of time (§§0149 and 0161).

13. Regarding Claims 13 and 48, Coult teaches displaying patent marking information on a computer display when detection occurs for the first time (§§0050, 0146, and 0149).

14. Regarding Claim 14, Coult teaches displaying patent marking information on a computer display in a periodic manner (§§0050, 0146, and 0149).

15. Regarding Claims 15, 31, and 49, Coult teaches displaying patent marking information in a Graphical User Interface (GUI) presented on a computer display (§§0050, 0146, 0149, and 0161).

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16. Regarding Claims 16 and 50, Coult teaches displaying patent marking information in a pop-up dialog box (§§0042, 0096, 0149-0151), wherein pop-up dialog box is operable to close upon receiving user input (§§0042, 0096, 0149-0151).

17. Regarding Claims 17, 32, and 51, Coult teaches the means which essentially comprise the same means as GUI includes one or more icons corresponding to one or more resources (§§0042, 0096, 0149-0151) and displaying patent marking information for a first resource of one or more resources when a user moves a cursor over an icon (§§0042, 0096, 0149-0151).

18. Regarding Claims 18, 33, and 52, Coult teaches the means which essentially comprises the same means as displaying the patent marking information for each resource proximate to the respective icon of each resource (§§0042, 0096, 0149-0151).

19. Regarding Claims 19 and 56, Coult teaches a change in one or more resources coupled to or comprised in the computer system and a change of user of the computer system (§§0052, 0069, 0071, and 0073).

20. Regarding Claims 20 and 57, Coult teaches the means which essentially comprises the same means as logging onto the system and logging off the computer system (i.e. user access to World Wide Web, §§0046, 0094, 0122, and 0123).

21. Regarding Claims 23 and 55, Coult teaches executing plug and play software to detect the resource (§§0042 and 0063).

22. Regarding Claims 25, 26, 60-81, 83, 84, 87, 88, 90, 91, 95-99, 101-104, the limitations of these claims have been noted in the rejections presented above. They are therefore rejected as set forth above.

CONCLUSION

23. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

a. Barney et al., "Method and system for rating patents and other intangible assets", Pat. No. 6,556,992;

b. Leah S. Larkey, "A Patent Search and Classification System", ACM 1999, pages 179-187; and

c. Christian Collberg and Clark Thomborson, "Software Watermarking: Models and Dynamic Embeddings", ACM 1999, pages 311-324.

NAME OF CONTACT

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Cheryl Lewis". The signature is fluid and cursive, with the first letter of each word being capitalized and prominent.

Cheryl Lewis
Patent Examiner
March 7, 2007